

REMARKS

In the Official Action dated November 23, 2010, the Examiner has set forth a requirement for restriction under 35 U.S.C. §121, alleging that the subject matter defined by the claims of the present invention represents the following distinct inventions:

I: Claims 11-14 and 16, drawn to a combination of a dental implant and a transfer part, classified in class 433, subclass 473;

II: Claim 17, drawn to a combination of an inner ampule and a transfer part, classified in class 433, subclass 141; and

III: Claims 18-21, drawn to an inner ampule, classified in class 433, subclass 163.

In order to be fully responsive to the Examiner's requirement for restriction, Applicants provisionally elect, with traverse, to prosecute the subject matter of Invention I. Claims 11-14 and 16 read on the elected invention. Applicants reserve the right under 35 U.S.C. §121 to file one or more divisional applications directed to the non-elected subject matter in present application in the event that the requirement for restriction is made final.

However, pursuant to 37 C.F.R. §§ 1.111 and 1.143, Applicants hereby traverse the Examiner's requirement for restriction and request reconsideration thereof in view of the following remarks.

An Examiner's authority to require restriction is defined and limited by statute:

If two or more independent and distinct inventions are claimed in one application, the Commissioner may require the application to be restricted to one of the inventions. 35 U.S.C. § 121, first sentence (emphasis added).

The implementing regulations of the Patent and Trademark Office include the mandate that restriction is appropriate only in cases presenting inventions which are

both independent and distinct, 37 C.F.R. §§1.141-142. Without a showing of independency and distinctness, a restriction requirement is unauthorized. In the present application, the claims which the Examiner has grouped separately are not "independent and distinct" so as to justify the restriction requirement.

Applicants respectfully submit that the combination of a dental implant and a transfer part as categorized in Invention I and the combination of an inner ampule and a transfer part as categorized in Invention II are linked to each other by a single inventive concept. Specifically, both independent Claims 11 and 17 recite, *inter alia*, “a clamping portion at the other end of the transfer part for the clamping connection of the transfer part to the dental implant, said clamping connection providing the sole connection between the transfer part and the implant, the clamping portion comprising a force transmission element for securing the clamping connection against rotation”. Thus, the subject matter of Invention I, as recited at least in Claim 11, and the subject matter of Invention II as recited in at least Claim 17 are linked to each other by a single inventive concept of a clamping portion. Therefore, Invention I and Invention II are related to each other, and are not independent and distinct.

In addition, reliance on the supposed classification of the groups of claims does not establish independence and distinctness. The classification system has no statutory recognition as evidence of whether inventions are independent and distinct. The classification system is instead an aid in finding and searching for patents and application publications.

The classification system is also an unreliable basis for requiring restriction between claims to the various aspects of Applicants’ unitary invention, because the system exhibits considerable overlap in technical definitions. In particular, the definitions of subclasses in the classification system do not prevent the Examiner from basing patentability decisions, as

to claims he assigned to one group, on patent references found in the subclass(es) with which he associated with another group of claims.

Furthermore, the classification system is a poor basis for requiring restriction between related aspects of an invention because classifications and definitions change over time. Thus, a classification that might have seemed to support restriction at a given time could change, thereby casting a shadow over the propriety of the restriction requirement later on during the term of the patents issuing from parent and divisional applications. Indeed, classifications seem largely to change in response to considerations of administrative convenience, and often in response to nothing more than growth in the number of patents in a given class or subclass. These considerations have nothing to do with whether the subject matter of patents assigned to different classifications is "independent and distinct" as those terms are used in 35 U.S.C. § 121, which fact proves that basing restriction requirements on the classification system is improper.

Applicants respectfully submit that a determination to make the pending restriction requirement final must evidence the patentable distinctness of all defined groups and species, one from the other.

In view of the foregoing, it is respectfully urged that the Examiner reconsider and withdraw the requirement for restriction and provide an action on the merits with respect to all the claims.

Respectfully submitted,



Peter I. Bernstein
Registration No. 43,497

SCULLY, SCOTT, MURPHY & PRESSER, P.C.
400 Garden City Plaza, Suite 300
Garden City, New York 11530
(516) 742-4343
PIB/HC/ech